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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/126,816	07/31/1998	CHRISTOPH VON EICHEL-STREIBER	PM254992	9336

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11/21/2001

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WASHINGTON, DC 200053918

EXAMINER

NICKOL, GARY B

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 11/21/2001

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/126,816

Applicant(s)

VON EICHEL-STREIBER ET AL.

Examiner

Gary B. Nickol Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Prosecution Application***

The request filed on 8-20-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/126816 is acceptable and a CPA has been established. Claims 21-29 are pending. An action on the CPA follows.

### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under domestic or foreign priority as follows: copies of the PCT and the EPO parent documents are not present in the file. Therefore, the Examiner is unable to determine whether the instant claims are to be granted priority back to the dates claimed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-29 are rejected as vague and indefinite for reciting "consisting essentially of approximately" as it is not clear what the limitations following such a phrase include or exclude; hence, the metes and bounds of the claims cannot be determined.

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Claims 21-29 are further rejected as vague for reciting "SEQ ID NO:1". It is noted that Applicants have correctly clarified the claim language with regards to the amino acid sequence as requested in Paper No. 13, page 3. However the claims remain vague because the information for SEQ ID NO:1., according to the official sequence listing (see Paper No. 11), appears to comprise DNA.

Claims 25-29 recite the limitation "a compound" in one of claims 22 to 24. There is insufficient antecedent basis for this limitation in the claim. This rejection can be obviated by amending the claims to recite "the compound according to one of claims 22 to 24".

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-24, 26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by any of Popoff (Infection and Immunity Vol 55(1)35-43 1987) or Roberts et al (WO/9422476 published 13 Oct 1994) as evidenced by Chaves-Olarte et al (J Biol Chem Vol 274 No 16 11046-11052 4/99) for the reasons of record in Paper No. 13, pages 7-9.

Applicants traverse this rejection for the reasons of record and again reiterate that Chaves-Olarte is not prior art to the instant application (Paper No. 16, page 5). This argument has been considered but it not found persuasive for reasons of record. Further, the Chaves-Olarte publication was used to evidence that the compositions of the prior art Popoff *et al.* or Roberts *et al.* read upon the claimed invention (see Paper No. 13, page 9).

Claims 21-24, 26, and 28 are rejected under 35 U.S.C. 102(a or b) as being anticipated by any of Green et al (Gene 161:57-61 1995) or von Eichel-Streiber et al (Mol Microbiol Vol 17(2) 313-321 1995) as evidenced by Chaves-Olarte et al (J Biol Chem Vol 274 No 16 11046-11052 4/99) for the reasons of record in Paper No. 13, pages 9-11.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Popoff (supra) or von Eichel-Streiber et al (supra) in combination with Blakey et al (Antibody Toxin Conjugates: A Perspective. Waldmann H. (ed): Monoclonal Antibody Therapy. Prog. Allergy. Basel, Karger, 1988 vol. 45 pp 50-90) for the reasons of record in Paper No. 13, pages 11-13.

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Claims 21-29 are rejected under 35 U.S.C. 102(a or b) as being anticipated by any of Green et al (Gene 161:57-61 1995) or von Eichel-Streiber et al (Mol Microbiol Vol 17(2) 313-321 1995) as evidenced by Chaves-Olarte et al (J Biol Chem Vol 274 No 16 11046-11052 4/99) for the reasons of record in Paper No. 13, pages 13-15.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Gary B. Nickol, Ph.D.  
Examiner  
Art Unit 1642

GBN  
November 13, 2001

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600